

Appln. Serial No. 09/829,614
Art Unit 3693
Attorney Docket: 25153-004

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Luis Eduardo Gutierrez-Sheris Examiner: Bartley, Kenneth
Serial No.: 09/829,614 Group Art Unit: 3693
Filed: April 10, 2001 Confirmation No: 7999
For: MONEY-TRANSFER TECHNIQUES

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

DECLARATION UNDER 37 C.F.R. § 1.131

S I R:

Ron Schwartzman declares as follows:

1. I am the Chief Operating Officer of UniTeller Financial Services, Inc. ("UniTeller"), the assignee of the above-referenced patent application ("Application"). I submit this Declaration for the purpose of establishing that the invention claimed in the Application ("Claimed Invention") has a date of invention prior to the August 15, 2000 priority filing date of U.S. Patent 7,120,608, which issued to Gallagher, et al., and also prior to the September 1, 2000 priority filing date of U.S. Pub. 2002/0029193, which issued to Ranjan and Shah, references cited during the examination of the Application.

2. As evidenced by copies of documentation annexed within the various exhibits, I submit that the claimed invention was conceived of prior to August 15, 2000, and further submit that UniTeller and UniTeller's then outside patent counsel collectively exercised reasonable diligence from at least just prior to August 15, 2000, until the filing of the Application in the U.S. Patent and Trademark Office on April 10, 2001.

3. I am submitting this Declaration, rather than the applicant, Mr. Luis Eduardo Gutierrez-Sheris ("Inventor"), since he is no longer employed by UniTeller.

4. I joined UniTeller in 2001 and have worked for UniTeller continuously on a full time basis from that date to the present.

5. Although I was not employed by UniTeller at the time the Application was filed, I am familiar with the history of UniTeller's initial development efforts in the field of money transfer systems that relate to the invention described and claimed in the Application. My knowledge, as set forth herein, is based on my communications with the Inventor and other employees of UniTeller who assisted in those development efforts and also based on my review and understanding of UniTeller's relevant business records. I submit that the documents annexed within the exhibits are true and correct copies of those documents included within UniTeller's files.

6. A copy of a memorandum, dated June 14, 1999, from the Inventor to Ms. Serena Skroupa ("1999 Memorandum") is annexed hereto as Exhibit A. Based

on my review of the 1999 Memorandum, this document sets forth a detailed description of procedures for accepting online money transfer transactions, and includes a discussion of three different models of the online system. The 1999 Memorandum includes a flow chart that depicts the online process from the point at which a customer logs onto a UniTeller.com web page on through entering payment data and ending with the customer reviewing his transaction online.

7. Based on my review of the 1999 Memorandum and my understanding of the claimed invention, I submit that the 1999 Memorandum clearly illustrates that the Claimed Invention was conceived of at least no later than June 4, 1999, the date of the 1999 Memorandum.

8. A copy of a letter, dated July 13, 2000, from Mr. Peter Michaelson to Mr. Zeke Ezekowitz ("July 13, 2000 letter") is annexed hereto as Exhibit B. Mr. Michaelson was UniTeller's then outside patent counsel ("Outside Counsel"). Mr. Ezekowitz was UniTeller's then in-house counsel ("In-House Counsel"). As is clear from the July 13, 2000 Letter, an initial draft of the Application had been prepared by Outside Counsel and was sent at that time to UniTeller's In-House Counsel.

9. A copy of a redacted email, dated August 11, 2000, from Mr. Todd DeYoung, UniTeller's then VP of Research and Development, to UniTeller's In-House Counsel ("August 11, 2000 Email") is annexed hereto as Exhibit C. The redacted material appears to represent confidential information. The August 11 2000 Email addresses the draft of the Application and presents comments and feedback. As is

apparent, the unredacted material of the August 11, 2000 Email addresses the need for various figures in the draft to be redone.

10. A copy of an email, dated October 19, 2000, from In-House Counsel to the Inventor ("October 19, 2000 Email") is annexed as Exhibit D. A copy of an email, dated November 2, 2000, from In-House Counsel to the Inventor ("November 2, 2000 Email") is annexed as Exhibit E. A copy of an email, dated November 17, 2000, from In-House Counsel to the Inventor ("November 17, 2000 Email") is annexed as Exhibit F. A redacted copy of an email, dated March 8, 2001, from In-House Counsel to Outside Counsel ("March 8, 2001 Email") is annexed as Exhibit G. The redacted material includes questions and suggestions pertaining to the draft of the Application and appears to represent privileged information. As is clear, the October 19, 2000 Email, the November 2, 2000 Email, the November 17, 2000 Email and the March 8, 2001 Email illustrate continuing consideration and efforts, including review, comment, questioning, and feedback, by UniTeller personnel of the draft of the Application.

11. Based on my review of the communications, some of those communications were highly technical thus supporting that there must have been prior review and analysis of relevant materials, including the draft application, which is evidence that there were continuing efforts in the matters at hand. It is noted that the Application as filed with the U.S. Patent and Trademark Office contains 94 pages of

text, and includes 30 claims, as well as 20 figures, which must have necessitated an extraordinary amount of time to properly review and comment on.

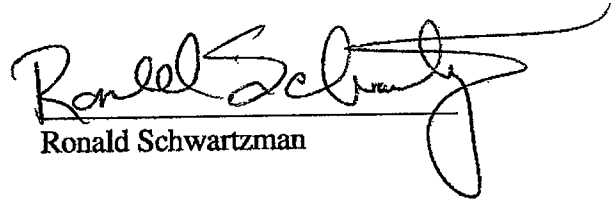
12. A redacted copy of an email, dated March 24, 2001, from Mr. Jerry Murray to In-House Counsel ("March 24, 2001 Email") is annexed hereto as Exhibit H. Based on the contents of the July 13, 2000 letter (Appendix B), Mr. Murray works with Outside Counsel. The redacted material is information provided by Outside Counsel that addresses the questions and suggestions set forth by UniTeller in the March 8, 2001 Email (Exhibit G).

13. A copy of an email, dated April 2, 2001, from In-House Counsel to Outside Counsel ("April 2, 2001 Email") is annexed hereto as Exhibit I. As is self-evident, the April 2, 2001 Email from In-House Counsel indicates that Mr. Murray's Email was received and instructs Outside Counsel to prepare the application for signature.

14. The Application was filed eight (8) days later with the U.S. Patent & Trademark Office on April 10, 2001, as evidenced by the official records at the U.S. Patent & Trademark Office.

15. In view of the foregoing discussion, I submit that the invention claimed in the Application was conceived of prior to August 15, 2000, and that UniTeller and UniTeller's then outside patent counsel collectively exercised reasonable diligence from at least just prior to August 15, 2000, until the filing of the Application in the U.S. Patent and Trademark Office on April 10, 2001.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statement and the like so made are punishable by fine or imprisonment or both, under section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.


Ronald Schwartzman

Dated: Rochelle Park, New Jersey
July 16, 2008